

**REMARKS:**

Claims 29-52, and 54-56 are currently pending in the application.

Claims 1-28 and 53 have been previously canceled, without *prejudice*.

Claims 34, 42, and 50 are currently canceled, without *prejudice*.

Claim 55 is allowed.

Claims 29-36, 45-52, 54, and 56 stands rejected under 35 U.S.C. § 101.

Claims 29-30, 32-33, and 35-36 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2008/0126265 to Livesay et al. (hereinafter “*Livesay*”) in view of U.S. Patent No. 7,406,436 to Reisman et al. (hereinafter “*Reisman*”) in further view of U.S. Patent No. 7,406,436 to Elad et al. (hereinafter “*Elad*”).

Claims 37-38, 40-41, 43-46, 48-49, and 51-52 stand rejected under U.S.C. § 103(a) over *Reisman* in view of *Elad*.

Applicant notes that *Reisman* was filed on 21 March 2002. The subject Application was filed on 28 June 2001, ***nine (9) months prior to the filing of Reisman***. It is noted, however, that *Reisman* claims priority to a provisional application filed 22 March 2001. Applicant believes, however, that the Applicant will be able to satisfy the requirements of 37 C.F.R. § 131 by filing a declaration showing a completion of the present invention prior to 22 March 2001, and respectfully reserve Applicant’s right to do so in the future during the pendency of the subject Application. Applicant also believes, however, that the present invention is not disclosed or fairly suggested by *Reisman*, and therefore, traverses the rejection of Claims 29-52 and 54-56 for at least the reasons recited below. However, if the Examiner intends to rely on the filing date of the *Reisman* provisional application, then Applicant respectfully requests that a showing under MPEP 2136.03 be made that “the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.”

Applicant respectfully submits that all of Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

#### **I. Rejections Under 35 U.S.C. § 101**

Claims 29-36, 45-52, 54, and 56 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. § 101 and respectfully requests that these rejections be withdrawn.

More specifically, Applicant respectfully submits that the Claims 29-36 and 54, which are directed to a "system," already provide ample reference to computer hardware such as "a server" and "a storage medium" to comply with the provisions of 35 U.S.C. § 101. Similarly, while Applicant respectfully submits that Claims 45-52 and 56, which are directed to "a computer-readable medium," are directed toward statutory subject matter in their prior, unamended form, Applicant submits current amendments to these claims to expedite prosecution and allowance of the subject application.

Accordingly, Applicant respectfully requests that the rejection of Claims 29-36, 45-52, 54, and 56 under 35 U.S.C. § 101 be withdrawn.

#### **II. Rejections Under 35 U.S.C. § 103(a)**

Claims 29-30, 32-33, and 35-36 stand rejected under 35 U.S.C. § 103(a) over *Livesay* in view of *Reisman* and *Elad*. Claims 37-38, 40-41, 43-46, 48-49, and 51-52 stand rejected under U.S.C. § 103(a) over *Reisman* in view of *Elad*.

Applicant respectfully submits that Claims 29-30, 32-33, 35-36, 37-38, 40-41, 43-46, 48-49, and 51-52 in their prior, unamended form contain unique and novel limitations that are not disclosed by *Livesay*, *Reisman* and *Elad*, whether taken individually or in combination. Thus, Applicant respectfully traverses the Examiner's obviousness rejection of Claims 29-30, 32-33, 35-36, 37-38, 40-41, 43-46, 48-49, and 51-52 under 35 U.S.C. § 103(a) over the proposed combination of *Livesay*, *Reisman* and *Elad*, whether taken individually or in combination.

Applicant thanks the Examiner for noting that Claims 31, 34, 39, 42, 47, 50, and 54-56 contain allowable subject matter. (7 September 2010 Office Action, page 3). Applicant further respectfully submits that despite Applicant's submission that Claims 29-30, 32-33, 35-36, 37-38, 40-41, 43-46, 48-49, and 51-52 are patentable over the cited references, Applicant submits current claim amendments to expedite allowance of the claims of the subject application and to more distinctly claim that which Applicant regards as the invention.

Furthermore, Applicant reserves the right to refile the prior, unamended claims and any canceled claims in a related application.

Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. § 103(a) are rendered moot in light of Applicant's current claim amendments. Accordingly, Applicant respectfully requests that these rejections be withdrawn and the claims of the subject application be allowed.

**III. Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Livesay-Reisman-Elad* Combination According to the UPSTO Examination Guidelines**

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Livesay*, *Reisman* and *Elad*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.**” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Livesay*, *Reisman* and *Elad*. The Office Action merely states that “it would have been obvious to a person in the ordinary skill in the art at the time of the invention to combine *Livesay* and *Reisman* by incorporating the teaching of *Reisman* into the system of *Livesay*.” (7 September 2010 Office Action, page 6). Applicant respectfully disagrees

and respectfully submits that the Examiner's conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Livesay, Reisman and Elad*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to "ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in "determining the scope and content of the prior art" such as, for example, "Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application." (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the "broadest reasonable interpretation consistent with the specification." (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any "*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Livesay, Reisman, Elad, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art*. The Office Action merely states that one "having ordinary skill in the art would have found it motivated to use the product categorization of Reisman into the system of Livesay for the purpose of leveraging XML schema when defining commerce or trade product in order to facilitate data exchange and parsing between partners." (7 September 2010 Office Action, pages 6-7). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Livesay, Reisman, Elad, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art*. Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious*." (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit*." (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness*.'" (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Livesay, Reisman and Elad to render obvious Applicant's claimed invention*. The Examiner's unsupported conclusory statements that "it would have been obvious to a person in the ordinary skill in the art at the time of the invention to combine Livesay and Reisman by incorporating the teaching of Reisman into the system of Livesay," and "having ordinary skill in the art would have found it motivated to use the product categorization of Reisman into the system of Livesay for the purpose of leveraging XML schema when defining commerce or trade product in order to facilitate data exchange and parsing between partners," *does not adequately provide clear articulation of the reasons why Applicant's claimed invention would have been obvious*. (7 September 2010 Office Action, page 6). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obviousness rejection based on the proposed combination of *Livesay, Reisman and Elad*, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

#### **IV. Applicant's Claims are Patentable over the Proposed *Livesay-Reisman-Elad* Combination**

Applicant respectfully submits that Claim 29 is considered patentably distinguishable over the proposed combination of *Livesay, Reisman and Elad*. This being the case, Claims 37, 45, and

54-56 are also considered patentably distinguishable over the proposed combination of *Livesay*, *Reisman* and *Elad*, for at least the reasons discussed above in connection with Claim 29.

Dependent Claims 30-36, 38-44, and 46-52 depend from Claims 29, 37, and 45, respectively. As mentioned above, each of Claims 29, 37, and 45 are considered patentably distinguishable over *Livesay*, *Reisman* and *Elad*. Thus, dependent Claims 30-36, 38-44, and 46-52 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, Applicant respectfully submits that Claims 29-52 and 54-56 are not rendered obvious by the proposed combination of *Livesay*, *Reisman* and *Elad*. Applicant further respectfully submits that Claims 29-52 and 54-56 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 29-52 and 54-56 under 35 U.S.C. § 103(a) be withdrawn and that Claims 29-52 and 54-56 be allowed.



**CONCLUSION:**

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

7 December 2010

Date

/Steven J. Laureanti/signed

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